



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

R2000-120

DEC 13 2000

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 2, 3, 17, 20, and 39 of the morning section and questions 10, 16, 27, 47, and 48 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 65. On July 19, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

**OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded two points for morning question 2 and 20. Accordingly, petitioner has been granted additional 2 points on the Examination. However, no credit has been awarded for morning questions 3, 17 and 39 and afternoon questions 10, 16, 27, 47 and 48.

Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

The model answer is choice (E).

Choice (E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that none of the answer (B) is incorrect and therefore answer (D) alone is correct. Petitioner contends that amendments are entered but claims are not entered as indicated in answer (B) and that when the fee for claims multiple dependent claims is received, the claims are examined for patentability and rejected or objected to. Petitioner concludes that answer (B) is incorrect and maintains that answer (D) is correct.

Petitioner’s argument has been fully considered but is not persuasive. Contrary to petitioner’s statement that amendments are entered, but not the claims, MPEP § 608.01(n)(top of p. 600-65) states that if a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. 37 C.F.R. § 1.121

(a)(2) specifies the manner of entering amendments containing claims. When an amendment

containing a new claim is entered, the new claim is implicitly entered. As to petitioner’s

argument that when the fee for claims multiple dependent claims is received, the claims are examined for patentability and rejected or objected to, this is true and only serves to reinforce the model answer; this argument does not contradict answer (B). Accordingly, both answers (B) and (D) are correct, rendering answer (E) correct. The statement in answer (E) is the most correct for including both answers (B) and (D). No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 17 reads as follows:

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

The model answer is choice (E).

(E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad "comprising" language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent

protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer.  
MPEP 2173.05(i).

Petitioner argues that answer (B) alone is correct. Petitioner contends that answer (C) is an improper aggregate claim and should be rejected for aggregation. Petitioner concludes that answer (C) is incorrect and maintains that answer (E) is incorrect for the same reason.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (C) is an improper aggregate claim and should be rejected for the aggregation, the elements of the claims do not lack cooperation. Accordingly, answer (C) is a proper claim, rendering answer (C) correct. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists \_\_\_\_\_

(A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.

(C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.

(E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent." (E) is incorrect because a (C) is correct.

Petitioner argues that none of the answers (A) through (D) are correct. Petitioner contends that broadening a limitation added during reissue nevertheless narrows the claim relative to the original claim and narrowing the claim is not impermissible recapture. Petitioner concludes that answer (E) is correct as declaring that the other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that broadening a limitation added during reissue nevertheless narrows the claim relative to the original claim and narrowing the claim is not impermissible recapture, the question specifically states that impermissible recapture exists if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application. As explained in the instructions, do not assume any additional facts not presented in the questions. Accordingly, the question does not state that such limitation is added during reissue, only that the limitation is broadened during reissue, rendering such broadening impermissible recapture. The statement in answer (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues that none of the answers is correct and answer (C) is the best answer

among the incorrect answers. Petitioner contends that Sam must file something because the

claims 2-10 are incomplete because they depend from canceled claim 1. Petitioner argues that answer (C) is best because that answer at least has Sam do something to preserve his client's rights. Petitioner concludes that answer (B) is incorrect and maintains that answer (C) is the best choice.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that Sam must file something because the claims 2-10 are incomplete because they depend from canceled claim 1, the question specifically states that the proceedings are those of reexamination. As explained in 37 C.F.R. § 10.23, a practitioner shall not engage in conduct invoking ... deceit. As to the dictionary definition provided for "fallacious" by petitioner, it is noted that the definition includes "deceitful" and "deceptive", rendering answer (C) incorrect because it asserts an action contrary to PTO rules and practices as invoking deceit. Contrary to petitioner's argument, no action is required. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required as per MPEP § 2260.01. The statement in answer (B) is correct and the statement in answer (C) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.



Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US CICT, 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the cases cited are not appropriate applications to the question in light of a purported omission in the MPEP on the examined point. Petitioner argues that the silence in the MPEP on the question of whether near simultaneous invention is evidence of level of skill is proof that the cited cases are not applicable. Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct because it is the only answer indicating all other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. The cases cited above are clearly applicable on the issue of whether nearly contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, "[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of 'the level of knowledge in the art at the time the

invention was made.' *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983)."

*Monarch Knitting* stated "[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art" at 1983, referring to *Merck*.

Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct and therefore answer (E) incorrect because (B) is correct. No error in grading has been shown.

Petitioner's request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. A patent application is filed with the following original Claim 1:

A steam cooker comprising:

- (i) a steam generating chamber having a steam generator;
- (ii) a cooking chamber adjacent to said steam generating chamber for receiving steam from said steam; and
- (iii) a heat exchanger secured within said steam generator, said heat exchanger including at least one heating zone comprised of an inner having raised surface projections thereon, an outer panel having raised surface projections thereon, and a path between said raised surface projections whereby flue gases may pass for heating the walls of the heat exchanger.

Assuming all of the following amendments are supported by the original disclosure in the specification, which amendment is in accord with proper PTO amendment practice and procedure?

(A) In Claim 1, line 4, after "steam" insert, --generator--.

(B) In Claim 1, line 6, after "inner" insert --panel--.

(C) In Claim 1, line 6, delete [one], insert --two--, and amend "zone" to read --zones--.

(D) In Claim 1, line 3, after "chamber" (second occurrence) delete [for receiving] and insert --to produce sufficient quantities of gas and--.

(E) In Claim 1, line 4, delete "secured within" and insert --attached to--.

The model answer is choice (B).

(B) is the most correct answer as per 37 C.F.R. § 1.121; MPEP § 714.22. The amendment in (B) specifies the exact matter to be inserted, the exact point where the insertion is to be made, and is limited to five words or less. (A) is also correct. (C) is incorrect because the amendment does not specify the exact point where the insertion of "two" is to occur. (D) is incorrect because the amendment would insert more than five words. (E) is incorrect because it fails to identify the correct point where the deletion and insertion is to be made.

Petitioner argues that because the PTO accepted either answer (A) or (B) as correct, all answers must be accepted as correct. Petitioner contends that the confusion created by at least 2 most correct answers renders both such answers unsuitable and therefore petitioner selected (C) as the most correct of the remaining answers. Petitioner further contends that the comma in answer (A) is inconsistent with PTO practice and given that credit is offered for such an incorrect answer, credit should be given for all incorrect answers. Petitioner concludes that all answers should be given credit.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that having two answers allowed credit should result in all answers receiving credit, answer (C) is clearly incorrect because the amendment fails to show where the exact point of insertion of "two" is to occur, and therefore should not receive credit. As to petitioner's argument that the comma in answer (A) renders answer (A) incorrect, that is not consistent with PTO rules and regulation. there is no rule on that point. The statements in answers (A) and (B) are correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 47 reads as follows:

47. Which of the following actions, if any, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with proper PTO rules and procedure?

I. Filing a request for reconsideration concerning the finality of the Office action, while the application is still pending before the primary examiner.

II. Filing a Notice of Appeal, then a brief, and arguing in the brief the impropriety of the finality of the rejection.

III. Filing a petition under 37 C.F.R. 1.181 based on improper finality of the rejection to stay the running of the period for reply set in the final Office action.

(A) I. only.

(B) II. only.

(C) III. only.

(D) I. and III.

(E) None of the above.

( The model answer is choice (A).

MPEP 706.07(c) and (d) set forth that prematureness of a final rejection may not be advanced as a ground for appeal. (II) is therefore improper. (II) is also improper because required fees have not been paid. 37 C.F.R. §§ 1.191 and 1.192. (III) is improper because the filing of the petition does not stay the period for reply. MPEP 1002. Thus, choices (B), (C), and (D) are incorrect. (E) is incorrect because (A) is correct.

Petitioner argues that none of the answers (A) through (D) are correct. Petitioner contends that MPEP 706.07 renders (I) incorrect because that MPEP section discusses the finality of the rejection instead of tenability of the rejection. Petitioner concludes that answer (A) is incorrect and maintains that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that tenability rather than finality is the appropriate argument in (I), the question specifically asks whether filing a request for reconsideration concerning the finality of

the Office action, while the application is still pending before the primary examiner, when taken as an initial step to dispute the propriety of the finality of an Office action, comports with Office rules. As explained in MPEP 706.07, any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. The question does not ask about arguing the merits of the action, but instead arguing about the finality of the action. Accordingly, MPEP 706.07 demonstrates that arguing the finality of a rejection while the application is pending before the primary examiner does comport with Office rules, rendering answer (I) correct. The statement in answer (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

(A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.

(B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the differences between the prior art and the claims would have been obvious.

(C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice (D).

(D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..."); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part of 'As A Whole' Inquiry"). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but structure and function carry more weight.

*In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

(B) is incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

(C) is incorrect. MPEP 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem).

(E) is incorrect. As stated in MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry"), "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)."

Petitioner argues that answer (B) is correct, although petitioner marked answer (E) on the exam answer booklet and stated that his answer was (E) at the beginning of his argument.

Petitioner contends that answer (D) is incorrect because it states that in delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are either inherent in the subject matter or disclosed in the specification. Petitioner argues that consideration is not necessarily given to subject matter that is inherent in the claim. Petitioner concludes that answer (D) is incorrect and maintains that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to

petitioner's statement that answer (D) is incorrect because it states that in delineating the

invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are either inherent in the subject matter or disclosed in the specification. the question specifically states that consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification. As explained in *In re Antonie*, such consideration is given. Accordingly, the statement in answer (D) is correct. Petitioner has not provided any argument as to why his answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.




**ORDER**

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



---

Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy